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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,037	03/26/2004	Thomas E. Falgout SR.	530	9542

7590 03/22/2005

John D. Jeter  
P.O. Box 846  
St. Martinville, LA 70582

EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/811,037

Applicant(s)

FALGOUT ET AL.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/18/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: annotated sheet from US 4,263,788.

*Election/Restrictions*

1. Applicant's election without traverse of Species I shown in Figs. 1 & 2 in the reply filed on Feb 24, 2005 is acknowledged.

In the reply, applicant argues that the embodiment in Fig. 3 should be included in Species I. However, in a phone conversation with applicant's representative, J. Jeter on March 9, 2005, applicant would not stipulate that the structures in Figs. 2 & 3 are obvious in view of each other. As such the structure in Fig.3 will not be considered along with the elected species.

2. Claims 5 & 8-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on Feb 24, 2005.

Claim 12 is directed to an assembly comprising "a third metal sleeve" and "a fourth metal" and so therefore fails to read on the elected species which has only two metal sleeves 13.

*Drawings*

3. The drawings are objected to because:

- a. The drawings fail to show the channel 3a described at page 4, line 15.
- b. Reference numerals 13A & 13B appear in Fig. 4 but are not mentioned in the description.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

5. The specification is objected to as failing to comply with 37 CFR 1.71 and 1.75(d)(1) because the detailed description fails to provide proper antecedent basis for the following claimed subject matter: (Line citations taken from the originally filed claim listing)

- a. Claim 1, line 4: “a first flexible coupling, having lubricant space”
- b. Claim 1, line 6: “a second flexible coupling, having lubricant space”
- c. Claim 1, line 10: “a closure for the lubricant space”
- d. Claim 1, line 16: “a closure for space”
- e. Claim 2: “two variable volume reservoirs”
- f. Claims 6 & 7: all limitations therein

*Claim Objections*

6. Claim 1 is objected to because: (Line citations taken from the originally filed claim listing)

- a. In line 18 , the word “first” should be changed to “second”
- b. Line 19 includes the nonsensical phrase “sealingly peripherally”.
- c. Line 20 should end with the word “and”

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 6 & 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Line citations taken from the originally filed claim listing)

- a. Claim 1 recites the limitation "the down hole motor output shaft" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 1, line 7 recites “a third end” but no second end is previously recited.
- c. Claim 1, line 16, recites the limitation, “space between the third and fourth ends”. Is this space the same as, or different from the space recited in line 6?
- d. Claim 1, line 22, recites the limitation "the un-occupied spaces". There is insufficient antecedent basis for this limitation in the claim.

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e. Claims 6 & 7 each recite the limitation "the elastomer sleeve". There is insufficient antecedent basis for this limitation in the claims because no single elastomer sleeve is previously identified.

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 6 & 7 rejected under 35 U.S.C. 102(b) as being anticipated by Beimgraben, US 4,263,788. Figs. 1 shows a coupling assembly 29 for connecting, as an axially serially continuation, a down hole motor rotor 21 to the down hole motor output shaft 11. Fig. 2c shows the coupling assembly 29 comprising (see the annotated copy attached): a first flexible coupling, having a lubricant space therein, arranged for connection, at a first end, to the output shaft 11; a second flexible coupling, having lubricant space therein, arranged for connection at a third end to the first coupling and arranged, at a fourth end arranged for connection to the motor rotor 21; a first flexible seal situated in the first flexible coupling, arranged to function as a closure for the lubricant space between the first and second ends, the seal comprising a first metal sleeve sealingly and peripherally attached at one end of the first coupling, a first elastomer sleeve sealingly and peripherally attached at one end to the distal end of the first metal sleeve sealingly and peripherally attached at the other end to the other end of the first flexible coupling; a second

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flexible seal situated in the second flexible coupling, arranged to function as a closure for space between the third and fourth ends, the seal comprising a second metal sleeve sealingly and peripherally attached to one end of the second coupling, a second elastomer sleeve peripherally attached at one end to the distal end of the second metal sleeve and “sealingly peripherally” attached at the other end to the other end of the second flexible coupling; and two variable lubricant reservoirs with fluid channels to provide lubricant to the couplings.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kramer, Williams and Warrington each show a coupling assembly for connecting, as an axially serially continuation, a down hole motor rotor to the down hole motor output shaft. Burkhardt and Moulindt each show a flexible seal.

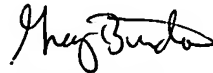
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

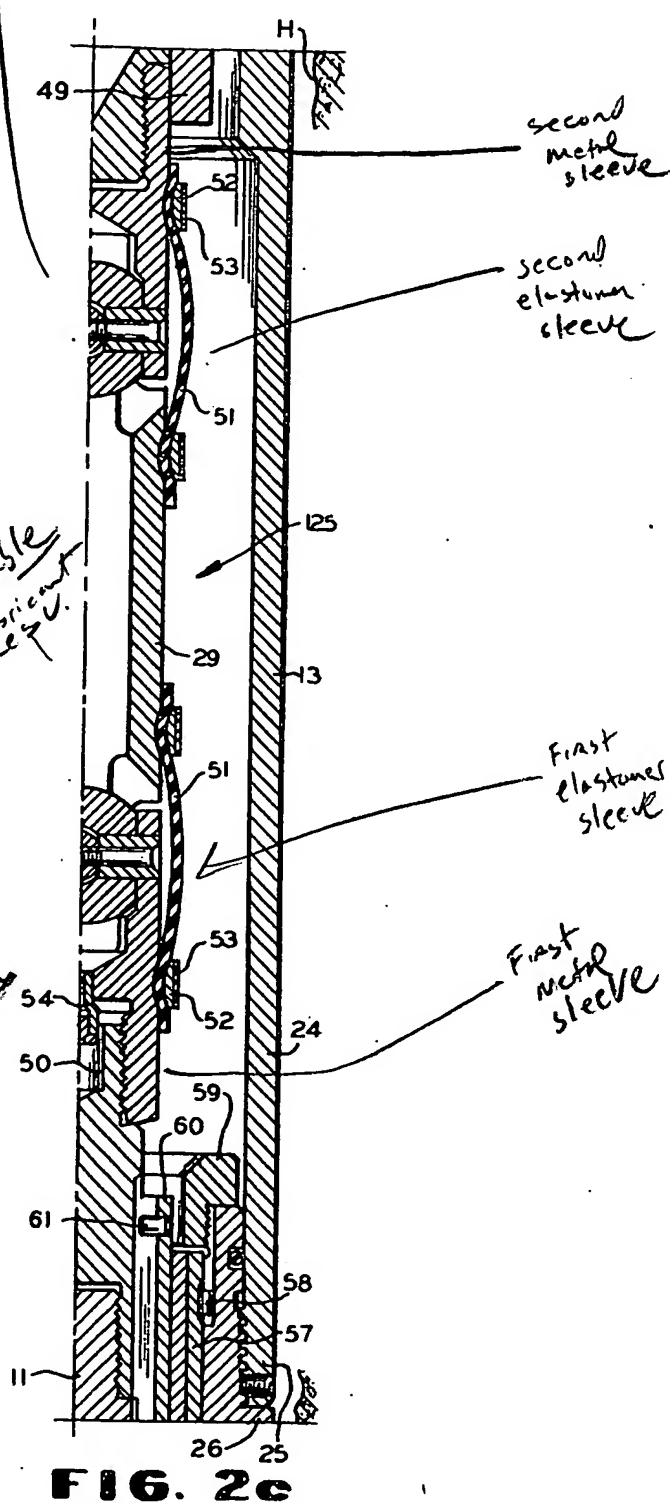
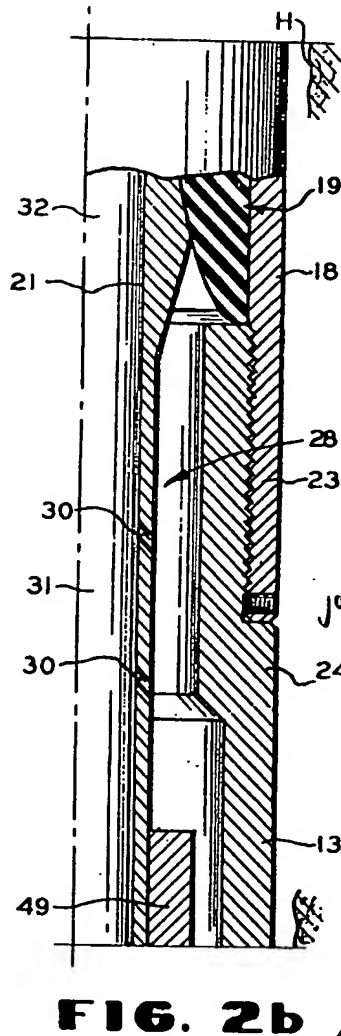
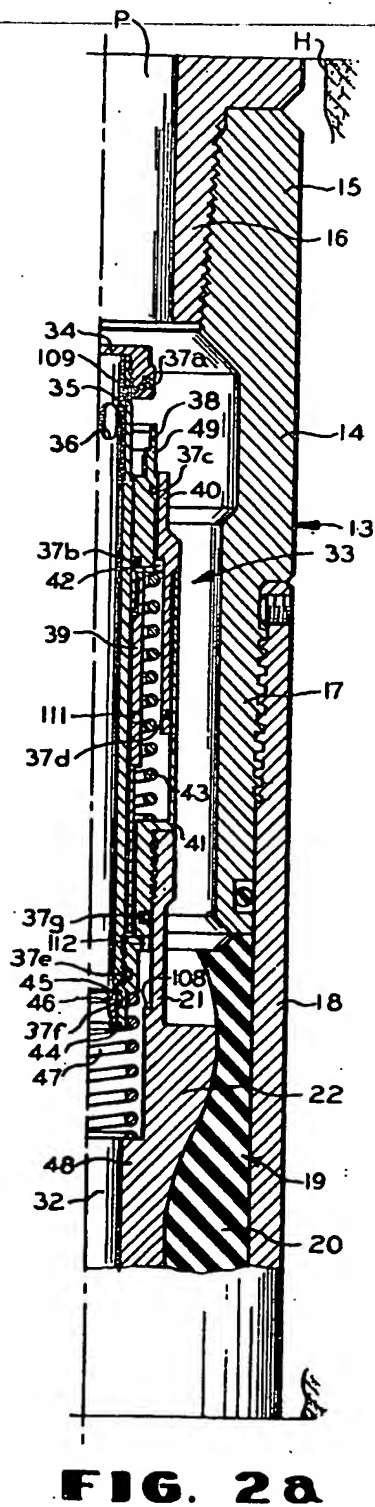


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Greg Binda  
Primary Examiner  
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Second flexible coupling

second metal sleeve

second elastomer sleeve

variable lubricant region

first elastomer sleeve

first metal sleeve

first flexible coupling

ANNOTATED SHEET